REMARKS

The Official Action mailed December 19, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

Claims 7-9 are pending in the present application, all of which are independent. Claims 7-9 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

In the "Response to Arguments" section, the Official Action states that "Applicant argued that there is no suggestion to combine the Fukuda and AAPA" (page 2, Paper No. 20061204). Although the Applicant included a general summary of MPEP §§ 2142-2143.01 (page 7, *Amendment* filed October 2, 2006), which includes the "teaching, suggestion, or motivation" requirement, the Applicant did not explicitly set forth arguments regarding the alleged motivation to combine Fukuda and AAPA. Rather, the Applicant argued that Fukuda and AAPA do not teach or suggest means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music (page 8, Id.).

The Official Action rejects claims 7-9 under 35 U.S.C. § 112, second paragraph. However, the rejection under § 112 is unclear. The Official Action first states that a portion of claims 7-9 is unclear, and then interprets the claims in a manner that is identical to that already recited in the claims. Specifically, please note, prior to the present *Amendment*, claims 7-9 recited "means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of claiming the copyright is judged to be included." The Official Action states that "It is unclear that in each claims it indicate that 'means contained in the control apparatus adapted to operate to initialize., when the information

of claiming the copyright is judged not to be included.'" (page 3, Paper No. 20061204). The Official Action does not explain what is believed to be unclear. Next, the Official Action states that "Therefore, it is being interpreted as 'means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included.' for examining purpose" (Id.). This statement is confusing in the context of a § 112 rejection, because the Examiner's statement of interpretation for examining purposes is nearly identical to that which is already claimed (i.e. the only difference between the claims prior to the present *Amendment* and the statement in the Official Action is that the Examiner has added "the" before "claiming the copyright"). Since the Examiner appears to be interpreting the claims in a manner that is, for all intents and purposes, identical to the actual features explicitly recited in the claims, then the Applicant respectfully submits that there is no basis for a rejection under § 112. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Also, the Official Action rejects claims 7-9 asserting a lack of antecedent basis for the recitation of "the completion of the recording of one piece of music." In response, claims 7-9 have been amended to positively recite "completion." It is noted that "recording" is already positively recited in each of the claims. The Applicant respectfully submits that amended claims 7-9 are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action continues to reject claims 7-9 as obvious based on the combination of U.S. Patent No. 6,594,740 to Fukuda and pages 2-4 of the present specification, which the Official Action refers to as "Applicant Admitted Prior Art (AAPA - Background Information)." The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 7-9 have been amended to recite means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus so as to shift to an editing work when the information of claiming the copyright is judged to be included and to extract title information from the acquired disk information of the target reproduction and store the extracted title information in the title area in the memory so as to shift to the editing work when the information of claiming the copyright is judged not to be included. Also, independent claims 7-9 have been amended to newly recite means contained in the control apparatus for generating an edit image in accordance with information in the memory in order to perform the editing work for the title information. Further, claim 7-9 already recite means for judging whether or not a track change has

occurred to decide completion of the recording of one piece of music. Fukuda and AAPA, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The alleged combination of Fukuda and AAPA does not teach or suggest means contained in a control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus so as to shift to an editing work when information of claiming a copyright is judged to be included and to extract title information from acquired disk information of a target reproduction and store the extracted title information in the title area in the memory so as to shift to the editing work when the information of claiming the copyright is judged not to be included. The Official Action concedes that "Fukuda does not expressly disclose transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music" (page 4, Paper No. 20061204), that "Fukuda did not expressly disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included" (page 5, Id.), and that "Fukuda did not expressly indicate the means for judging whether or not a track change has [occurred] to decide the completion of the recording of one piece of music" (page 6, Id.). The Official Action asserts that the disclosure at pages 2-4 of the present specification cures these deficiencies in Fukuda. The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Page 3, lines 1-2, of the present specification appears to describe a step S103 (Figure 7) where a control microprocessor judges whether the read text data contains information of claiming a copyright. However, the process subsequent to step S103 is different from a step following a judging step in the present invention. Specifically, in the present invention, for example, when any copyright is judged to exist, the title area of the memory 35 is initialized (Figure 5, step S37) and subsequently the edit image is generated in accordance with the information in the memory 35 (Figure 5, step S38).

That is, the system shifts to the title edit process. In order to better recite this feature, the claims have been amended to recite "so as to shift to an editing work." In contrast, in the process described at pages 2-4 of the present specification, when any copyright is judged to exist, the write memory is initialized (Figure 7, S105) and subsequently the character information is written into the memory one character after another (one at a time) in accordance with key input (Figure 7, steps S105 to S108). The present amended claims clearly recite that after it is judged whether the acquired disk information includes information of claiming a copyright, a title area in a memory is initialized or the extracted title information is stored in the title area in the memory and subsequently the system shifts to an editing work and the editing work for the title information is performed. The claimed processing operations are not performed in the alleged combination of Fukuda and AAPA.

Also, independent claims 7-9 newly recite means contained in the control apparatus for generating an edit image in accordance with information in the memory in order to perform the editing work for the title information. The Applicant respectfully submits that the alleged combination of Fukuda and AAPA does not teach or suggest the above-referenced features of the present claims.

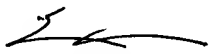
Further, the Official Action concedes that "Fukuda did not expressly indicate the means for judging whether or not a track change has [occurred] to decide the completion of the recording of one piece of music" (page 6, Paper No. 20061204). The Official Action asserts that AAPA teaches these features at page 2, lines 24-25 (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Page 2, lines 24-25, of the present specification appears to disclose the following: "This title information registration process starts, for example, when music data is completely recorded from CD to MD" (emphasis added). That is, the process described at pages 2-4 is related to the completion of the recording of a complete CD to MD and does not relate to "the recording of one piece of music" as presently claimed and defined in the present specification.

Since Fukuda and AAPA do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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